

Applicants :	Maldini et al.	Atty. Dkt. No.	:	1130-PCT-US	
USPN	:	10/554,181	Art Unit	:	1636
Filed	:	12/27/2005	Date of Office Commn.	:	11/12/2009
Examiner	:	Catherine S. Hibbert	Date of Response	:	1/11/2010
Page	:	6			

REMARKS

Claim Status

Claims 1 and 3-18 are pending in this application. Claim 1 has been amended. Accordingly, Applicants believe there is no issue of new matter.

Applicants hereby respectfully request entry of this Amendment. Upon entry of this Amendment, claims 1 and 3-18, will be pending and under examination in this application.

Rejections Under 35 U.S.C. §102

1. Claims 1, 3-4 and 6-15 are rejected under 35 U.S.C 102(e) as being anticipated by Chtarto et al. (U.S. Pat. No. 6,780,639). This rejection is respectfully traversed.

In response to Applicants' lengthy discussion, the Examiner only contends that

Applicants arguments are not commensurate with the scope of the claims, as written. For example, Applicants argument (just above) stating the "present invention offers the construction of a bidirectional promoter comprising a minimal viral promoter and a full length eukaryotic promoter" is not commensurate with the claim language of the amended base Claim 1 which does not refer to "a full length eukaryotic promoter" ...

The Examiner has not raised any other objection. Accordingly, Applicants has amended claim 1 to recite "*an eukaryotic promoter sequence of an animal gene comprising an enhancer region and a second minimal promoter sequence*". Applicants submit that the scope of amended claim 1 is commensurate with Applicants' argument.

Since Chtarto does not teach each and every aspect of the present invention, namely Chtarto does not teach an eukaryotic promoter as claimed herein, Chtarto does not anticipate claim

Applicants :	Naldini et al.	Atty. Dkt. No.	:	1130-PCT-US	
USSN	:	10/554,181	Art Unit	:	1636
Filed	:	12/27/2005	Date of Office Commn.	:	11/12/2009
Examiner	:	Catherine S. Hibbert	Date of Response	:	1/11/2010
Page	:	7			

1 as amended. Accordingly, Applicants respectfully request that the rejection of claims 1, 3-4 and 6-15 under 35 U.S.C 102(e) be withdrawn.

2. Claims 1, 3-4, 6-11 and 13-18 are rejected under 35 U.S.C 102(e) as being anticipated by Itoh et al. (U.S. Pat. No. 6,995,011). This rejection is respectfully traversed.

The Examiner's response to Applicants' argument is the same as discussed above; hence, Applicants has amended claim 1 to recite "*an eukaryotic promoter sequence of an animal gene comprising an enhancer region and a second minimal promoter sequence*". Applicants submit that the scope of amended claim 1 is commensurate with Applicants' argument.

Since Itoh does not teach each and every aspect of the present invention, namely Itoh does not teach an eukaryotic promoter as claimed herein, Itoh does not anticipate claim 1 as amended. Accordingly, Applicants respectfully request that the rejection of claims 1, 3-4, 6-11 and 13-18 under 35 U.S.C 102(e) be withdrawn.

3. Claims 1-4, 7-8, 10 and 14 are rejected under 35 U.S.C 102(b) as being anticipated by Fux et al. This rejection is respectfully traversed.

The Examiner's response to Applicants' argument is the same as discussed above; hence, Applicants has amended claim 1 to recite "*an eukaryotic promoter sequence of an animal gene comprising an enhancer region and a second minimal promoter sequence*". Applicants submit that the scope of amended claim 1 is commensurate with Applicants' argument.

Applicants :	Maldini et al.	Atty. Dkt. No.	:	1130-PCT-US	
USSN	:	10/554,181	Art Unit	:	1636
Filed	:	12/27/2005	Date of Office Commn.	:	11/12/2009
Examiner	:	Catherine S. Hibbert	Date of Response	:	1/11/2010
Page	:	8			

Since Fux does not teach each and every aspect of the present invention, namely Fux does not teach an eukaryotic promoter as claimed herein, Fux does not anticipate claim 1 as amended. Accordingly, Applicants respectfully request that the rejection of claims 1-4, 7-8, 10 and 14 under 35 U.S.C 102(b) be withdrawn.

Rejections Under 35 U.S.C. §103

Claim 5 is rejected under 35 U.S.C 103 (a) as being unpatentable over Chtarto et al. or Ithoh et al., in view of Hope et al. (US 6,136,597). This rejection is respectfully traversed.

The Examiner's response to Applicants' argument is the same as discussed above; hence, Applicants has amended claim 1 to recite *"an eukaryotic promoter sequence of an animal gene comprising an enhancer region and a second minimal promoter sequence"*. Applicants submit that the scope of amended claim 1 is commensurate with Applicants' argument.

claim 5 is dependent from claim 1. As discussed above, the combination of Chtarto and Ithoh does not teach each and every aspect of the present invention. Hence, the combination of Chtarto, Ithoh and Hope would also not teach each and every aspect of the present invention. Accordingly, Applicants respectfully request that the rejection of claim 5 under 35 U.S.C 103(a) be withdrawn.

Applicants :	Maldini et al.	Atty. Dkt. No.	:	1130-PCT-US	
USSN	:	10/554,181	Art Unit	:	1636
Filed	:	12/27/2005	Date of Office Commn.	:	11/12/2009
Examiner	:	Catherine S. Hibbert	Date of Response	:	1/11/2010
Page	:	9			

Conclusion

Applicants respectfully maintain that all of the grounds of rejections and objections raised in the November 12, 2009 Office Action have been fully addressed. Accordingly, the Application has fulfilled all requirements. Applicants earnestly urge the Examiner to put the Application in condition for allowance.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below. No fee is deemed necessary in connection with the submission of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan / HKL

Albert Wai-Kit Chan
Registration No. 36,479
Attorney for Applicants
Law Offices of
Albert Wai-Kit Chan, PLLC
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, New York 11357
Tel: (718) 799-1000
Fax: (718) 357-8615
E-mail: chanak@kitchanlaw.com